



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marise Chan et al. Examiner: Vaughn, Gregory J.
Serial No.: 09/755,863 Group Art Unit: 2178
Filed: January 5, 2001 Docket: 60001.0005US01/MS154627.1
Confirmation No.: 3683 Due Date: January 14, 2007
Title: Enhanced Find and Replace for Electronic Documents

CERTIFICATE UNDER 37 CFR 1.8:

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By: 
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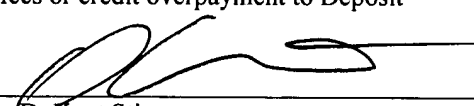
Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet in duplicate containing Certificate of Mailing
- ☒ Reply Brief Under 37 C.F.R. 41.41 in Response to Examiner's Answer
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marise Chan, et al. Examiner: Gregory J. Vaughn
Serial No.: 09/755,863 Group Art Unit: 2178
Filed: January 5, 2001 Docket No.: 60001.0005US01/MS154627.1
Title: ENHANCE FIND AND REPLACE FOR ELECTRONIC DOCUMENTS

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By: 

Name: Merri D. Cruz

REPLY BRIEF UNDER 37 C.F.R. § 41.41 IN RESPONSE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

Dear Sir:

The Appellants hereby submit a brief in reply to the Examiner's Answer dated November 14, 2006 in the patent application identified above. A Notice of Appeal was filed on May 15, 2006 and an Appeal Brief was filed on July 13, 2006.

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REAL PARTY OF INTEREST

The real party of interest is Microsoft Corporation of Redmond, Washington. An Assignment is of record in the application.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claim	Status
1	Cancelled
2	Rejected
3-4	Cancelled
5-7	Rejected
8-20	Cancelled
21-22	Rejected
23	Cancelled

Rejected Claims 2, 5-7, 21 and 22 are being appealed.

A clean copy of Claims 2, 5-7, 21, and 22 involved in this appeal is attached as an Appendix.

STATUS OF AMENDMENTS

All Amendments to date have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

See Amended Appeal Brief filed August 15, 2006 (hereinafter the "Appeal Brief") pages 4-5.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. First Ground of Rejection

Claims 2 and 22 are rejected under 35 USC 103 (a) as being unpatentable over Underdahl "Using Quattro Pro 6 for Windows" (hereinafter "Underdahl") in view of "WordPerfect V6.1 User's Guide" (hereinafter "WordPerfect").

Regarding independent Claim 2, the rejection asserts that Underdahl discloses moving a cursor over a cell in the spreadsheet containing a plurality of formatting characteristics and clicking a mouse button to select the cell, whereby in response to selecting the cell the formatting characteristics of the selected cell are determined and applied to the plurality of fields in the dialog. The rejection also asserts that WordPerfect teaches using a "Find/Replace" dialog which allows determining and editing formatting characteristics. The rejection concludes that it would have been obvious, to one of ordinary skill in the art, to enhance the "Find/Replace" dialog of Underdahl with the format capabilities taught by WordPerfect in order to allow a search of spreadsheet cells based upon text and formatting characteristics.

Independent Claim 22 is rejected using the same rationale as independent Claim 2.

II. Second Ground of Rejection

Dependent Claims 5 and 21 are rejected under 35 USC § 103(a) as being unpatentable over Underdahl in view of WordPerfect, and further in view of “Corel Draw” (hereinafter “Corel”).

Regarding dependent Claim 21, the rejection asserts that Underdahl discloses selecting an option for choosing formatting characteristics from a formatted cell in a spreadsheet. The rejection acknowledges that Underdahl and WordPerfect fail to disclose the cursor changing to a second shape, indicating to the user that selecting a cell will apply the attributes to the find dialog box. However, Corel is applied as teaching the user of a plurality of special-shape cursors that indicate to the user the special functionality currently associated with the special cursor shape. The rejection concludes that it would have been obvious to one of ordinary skill to use a special shaped cursor, as taught by Corel, with the find/replace dialog with cell selection with a mouse as allegedly taught by Underdahl and WordPerfect in order to provide a visual indicator to the user as to the currently-enabled function of the cursor.

Regarding dependent Claim 5, the rejection asserts that Corel teaches the shape of the cursor as an eyedropper and concludes that it would have been obvious to one of ordinary skill to use an eyedropper-shaped cursor, as taught by Corel, with the above-mentioned elements of Underdahl and WordPerfect.

III. Third Ground of Rejection

Claims 6 and 7 are rejected under 35 USC § 103(a) as unpatentable over Underdahl in view of WordPerfect and Corel, and further in view of Microsoft Excel 2000

as depicted in screen captures created by the Examiner (hereinafter "Excel"). The rejection applies Underdahl and WordPerfect substantially as in the First and Second Grounds, and admits that Underdahl and WordPerfect fail to disclose formatting characteristics comprising a plurality of number fields, a plurality of alignment fields, a plurality of font fields, a plurality of border fields, a plurality of pattern fields, or a plurality of protection fields. However, Excel is cited as disclosing characteristics comprising each of those fields. The rejection asserts that it would have been obvious to one of ordinary skill to determine the formatting characteristics of Underdahl, WordPerfect, and Corel with the cell format controls as taught by Excel, in order to use all possible formatting characteristics of a cell for a searching function.

AUGUMENT

The arguments presented in the Appeal Brief are hereby incorporated by reference in their entirety. See Appeal Brief, pages 7-14.

I. First Ground: Rejection Under 35 U.S.C. § 103(a) over Underdahl in view of WordPerfect

Regarding independent Claim 2, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case of obviousness. In addition, in the Examiner's Answer dated November 14, 2006 (hereinafter "Examiner's Answer"), the Examiner has failed to address all arguments set forth in the Appeal Brief. Specifically, the Examiner's Answer has failed to address Appellants' claim that one of ordinary skill, facing the problem solved by the Appellants, would not have found teachings in either Underdahl or WordPerfect to combine those references as the rejection suggests. See Appeal Brief, page 10, lines 10-16.

Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements:

- (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings;
- (ii) a reasonable expectation of success; and
- (iii) the prior art references must teach or suggest all claim limitations.

See MPEP §2143; In re Dembiczak, 175 F.3d 994 (Fed. Cir 1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996). Therefore, a three prong test must be applied when attempting to make a *prima facie* case of obviousness. The first prong requires that there must be some suggestion or motivation to combine the cited references. The second prong requires that there must be a reasonable expectation of success. And the third prong requires that the cited references must teach all claim limitations. All three prongs must be met to make a *prima facie* case of obviousness.

a. The First prong

The cited references used in the rejection fail at least the first prong of obviousness in that there is no suggestion or motivation to combine the cited references. While Appellants do not admit that the cited references can be combined, “[t]he fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.” See MPEP §2143.01(III) citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In addition, even if the cited references could be combined, the cited references must suggest the claimed invention’s desirability. See

MPEP § 2143.01(I). The proper inquiry in determining the claimed invention's desirability is "whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination." See MPEP § 2143.01(I)(4); In re Fulton, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004). (Original Emphasis.)

Appellants respectfully submit that the references do not "suggest the desirability of the combination." The Action merely states, "[i]t would have been obvious, to one of ordinary skill in the art, at the time the invention was made to enhance the "Find/Replace" dialog of Underdahl with the format capabilities as taught by WordPerfect V6.1 in order to allow a search of spreadsheet cells base upon text and formatting characteristics." See Final Office Action dated January 11, 2006, page 7, third paragraph. Appellants respectfully submits that MPEP § 2143.01(IV) citing AI-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) states: "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references." In In re Kotzab, the courts reversed obviousness rejections involving technologically simple concepts because there was no finding as to the principle or specific understanding in the references that would have motivated a skilled artisan to make the claimed invention. See In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

Neither the prior Office Actions nor the Examiner's Answer point to "the principle or specific understanding in the references that would have motivated a skilled artisan to make the claimed invention." Rather, the Examiner merely states that it would have been obvious to combine the references. In other words, the Examiner has not pointed

to a principle or a specific understanding in the references as required by the first prong. Accordingly, Appellants respectfully submit that the Examiner has failed the first prong of obviousness in that there is no suggestion or motivation to combine the cited references.

b. The Third Prong

While Appellants submit that there are no teachings or suggestions in any of the cited references that they are combinable to produce Appellants' claimed invention, even if such a combination were possible, the combination still would not produce Appellants' claimed invention. In other words, Appellants submit that the references used in the Final Office Action dated January 11, 2006 additionally fail the third prong of obviousness, because the cited references do not teach or suggest all of the limitations of Claim 2. MPEP §2143.03 citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) states that "[t]o establish *prima facie* obviousness of a claimed invention, ***all the claim limitations*** much be taught or suggested." (Emphasis added.) Appellants respectfully submit that the cited references fail to teach or suggest all claim limitations. See Appeal Brief, pages 7-10 for discussion concerning elements not taught or suggested by Underdahl or WordPerfect.

This rejection relies on the Examiner's finding that Underdahl discloses "moving a cursor over a cell in a spreadsheet... and clicking a mouse button to select the cell, whereby... the formatting characteristics of the selected cell are determined and applied to the plurality of fields of the [find] dialog". That finding is not correct. In fact,

Underdahl lacks support for that key portion of each ground of rejection under appeal.

Underdahl states:

"To change the display format of a cell or block, first highlight the cell or block, then click the right mouse button inside the cell or block... to open the Active Block Object Inspector dialog box. The Numeric Format pane is selected by default. If no numeric format has been assigned, the default General format is checked, as shown in Figure 6.7." See Page 193.

However, if a user chooses one of several specified formats, Underdahl then instructs the user to "type the number of decimal places in the text box [of the dialog box] that appears after you choose one of these formats." As a result Underdahl discloses the following steps:

- 1) Highlight a cell or block;
- 2) Right-click the cell (or press F12) to open a dialog box;
- 3) Choose among several kinds of formats (unless General numeric is desired by default);
- 4) Type the desired formatting (e.g., decimal places) into the dialog box; and then
- 5) Choose OK to confirm the dialog box and apply the formatting to the highlighted cell or block.

Underdahl does not disclose a computer-implemented method to determine formatting characteristics of a selected cell and apply those formatting characteristics to fields in a dialog box in response to selecting the cell, as recited by Claim 2. In contrast, Underdahl merely discloses the mirror-opposite, namely, selecting a cell, opening (by right clicking) a dialog box referencing that selected cell, and then entering in that dialog box the formatting desired for the selected cell or block.

The method disclosed by Underdahl, which requires the user to determine the desired formatting characteristics and apply them to the fields of the dialog box, is thus

contrary to the recitation of Claim 2, namely, "whereby in response to selecting the cell the formatting characteristics of the selected cell are determined and applied to the plurality of fields of the find dialog."

The Examiner has argued that Underdahl shows how to apply formatting where there was none previously. See Advisory Action dated April 25, 2006. Citing the statement on page 193 of Underdahl that "if no numeric format has been assigned, the default General Format is checked", the Examiner asserts that statement "clearly demonstrates" that whatever formatting is assigned to the cell, in Underdahl, that formatting information is determined and shown in the dialog box. That argument disregards the plain teaching of Underdahl and further highlights the significant difference between Underdahl and the method of Claim 2. Underdahl actually shows that formatting inside the cell is determined by user-inputted data to the dialog box. See Underdahl, page 193. In Underdahl, the user checks one of several specific numeric formats and then types the number of decimal places in the text box after choosing that format, Underdahl then applies that user-inputted format to the highlighted cell or block after the user chooses OK to confirm the dialog box.

In Underdahl, the formatting of the selected cell does not drive the contents of the dialog box, but rather, the contents of the dialog box drives the formatting of the cell. Thus, the requirements of independent Claim 2 where, in response to selecting a cell, the formatting characteristics of that cell are determined and applied to the fields in the find dialog are missing from Underdahl.

Since independent Claim 22 is rejected using the same rationale as independent Claim 2 Appellants respectfully submit that the arguments for independent Claim 2 apply to independent Claim 22.

Accordingly, Appellants respectfully submit that the Examiner has failed at least the first and third prongs of obviousness in that there is no suggestion or motivation to combine the cited references and the cited references do not teach or suggest all the claim limitations. Accordingly Appellants respectfully request the first ground of rejection be reversed by the Board and independent Claims 2 and 22 be passed to issue.

II. Second Ground of Rejection: Rejection Under 35 U.S.C. § 103(a) over Underdahl in view of WordPerfect, and further in view of Corel

Dependent Claims 5 and 21 are rejected under 35 USC § 103(a) as being unpatentable over Underdahl in view of WordPerfect, and further in view of Corel. Claim 21 depends from Claim 2. Claim 5 depends from Claim 21. Appellants respectfully submit that the arguments in favor of independent Claim 2 apply equally against the second ground of rejection. Furthermore, dependent claims 5 and 21 are also allowable at least by virtue of their dependency upon independent Claim 2. See MPEP §2143.03¶1; In re Fine, 837 f.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly Appellants respectfully request the first ground of rejection be reversed by the Board and dependent Claims 5 and 21 be passed to issue.

III. Third Ground of Rejection: Rejection Under 35 U.S.C. § 103(a) over Underdahl in view of WordPerfect and Corel, further in view of Excel

Dependent Claims 6 and 7 are rejected under 35 USC § 103(a) as being unpatentable over Underdahl in view of WordPerfect, and further in view of Corel. Claim 6 depends from Claim 5. Claim 7 depends from Claim 6. The rejection applies Underdahl and WordPerfect substantially as in the First and Second Grounds, and admits that Underdahl and WordPerfect fail to disclose formatting characteristics comprising a plurality of number fields, a plurality of alignment fields, a plurality of font fields, a plurality of border fields, a plurality of pattern fields, or a plurality of protection fields. Appellants respectfully submit that the arguments in favor of independent Claim 2 apply equally against the third ground of rejection.

Furthermore, dependent claims 6 and 7 are also allowable at least by virtue of their dependency upon independent Claim 2. See MPEP §2143.03^{¶1}; In re Fine, 837 f.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly Appellants respectfully request the first ground of rejection be reversed by the Board and dependent Claims 6 and 7 be passed to issue.

CONCLUSION

In closing, Appellants respectfully submit that the rejected claims define patentable subject matter over the applied art and request the Board to reverse the rejections of those claims.


While no fees are believed due, the Commissioner is authorized to charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,
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CLAIMS APPENDIX

2. A computer-implemented method for populating a plurality of fields in a find dialog of a spreadsheet program module, the method comprising the steps of:

choosing a plurality of formatting characteristics of a cell in the spreadsheet;

editing the plurality of fields in the find dialog to correspond to the plurality of formatting characteristics of the cell; and

wherein the step of choosing the plurality of formatting characteristics of the cell in the spreadsheet is performed in response to moving a cursor over the cell containing said plurality of formatting characteristics and clicking a mouse button to select the cell, whereby in response to selecting the cell the formatting characteristics of the selected cell are determined and applied to the plurality of fields of the find dialog.

5. The method of claim 21, wherein the second shape of the cursor is shaped like an eyedropper.

6. The method of claim 5 wherein the plurality of fields in the find dialog comprise a plurality of number fields, a plurality of alignment fields, a plurality of font fields, a plurality of border fields, a plurality of pattern fields and a plurality of protection fields.

7. A computer-readable medium having computer-executable instructions for performing the steps recited in claim 6.

21. The method of Claim 2, wherein:

the step of choosing the plurality of formatting characteristics of the cell in the spreadsheet further comprises selecting an option of choosing the formatting characteristics from a formatted cell in the spreadsheet; and

in response to selecting the option, changing the shape of the cursor from a first shape to a second shape distinct from the first shape,

whereby the distinct second shape denotes to a user that moving the cursor over a cell and clicking the mouse button will determine the formatting characteristics of that cell and apply the formatting characteristics of that cell to the fields of the find dialog.

22. A computer-implemented method for populating a plurality of fields defining certain formatting characteristics in a find dialog of a spreadsheet program module, the method comprising:

choosing a plurality of formatting characteristics of a formatted cell in the spreadsheet by moving a cursor over the cell and clicking a mouse button to select the cell; and

in response to selecting the cell, determining the formatting characteristics of the selected cell and populating the determined formatting characteristics to the fields in the find dialog.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None